REMARKS

In the non-final Office Action, the Examiner rejected claims 1-7, 9-11, 16-18, 20-29, 34-36, and 42-47 under 35 U.S.C. § 102(e) as anticipated by Rodriguez et al. (U.S. Patent Publication No. 2002/0067806); rejected claims 12, 13, 30, and 31 under 35 U.S.C. § 103(a) as unpatentable over Rodriguez et al. in view of McAllister et al. (U.S. Patent No. 6,442,242); rejected claim 19 under 35 U.S.C. § 103(a) as unpatentable over Rodriguez et al. in view of Schiavone et al. (U.S. Patent Publication No. 2002/0120600); and rejected claims 14, 15, 32, 33, 37-41, 48, and 49 under 35 U.S.C. § 103(a) as unpatentable over Rodriguez et al. in view of Tullis et al. (U.S. Patent No. 5,802,314).

Applicants respectfully traverse the rejections for the reasons that follow. Claims 1-7 and 9-49 are pending.

In paragraph 4 of the Office Action, the Examiner rejected claims 1-7, 9-11, 16-18, 20-29, 34-36, and 42-47 under 35 U.S.C. § 102(e) as allegedly anticipated by Rodriguez et al. Applicants traverse the rejection.

Claim 1, for example, is directed to a combination of features of a method for delivering a message to a receiving party. The method includes receiving a message intended for the receiving party, determining whether the message should be delivered to the receiving party, and translating the message from a source format to message text. The method further includes converting the message text to an audible message when the message should be delivered to the receiving party, initiating a telephony call to the receiving party, and delivering the audible message to the receiving party during the telephony call.

A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention either expressly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. Rodriguez et al. does not disclose or suggest features recited in claim 1. For example, Rodriguez et al. does not disclose or suggest translating a message from a source format to message text.

The Examiner alleged that Rodriguez et al. "teaches inherently translating the message from a caller's analog voice to digital form" and cited paragraphs 0024 and 0025 of Rodriguez et al. for support (Office Action, page 3). Applicants submit that the Examiner is misinterpreting the disclosure of Rodriguez et al.

At paragraphs 0024 and 0025, Rodriguez et al. discloses:

> FIG. 1a shows a system diagram of a caller leaving an urgent message. Caller 100 dials a phone number corresponding with unavailable receiver 120. The phone signal travels through telephone network 110 in order to ring the phone corresponding with unavailable receiver 120. When unavailable receiver 120 does not answer, telephone answering system 140 answers and prompts caller 100 for a message and a priority. Telephone network 110 may include a mobile telephone network, the public switched telephone network, or a private telephone exchange within an organization.
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> While telephone answering system 140 is shown attached to telephone network 110, in some embodiments, such as a stand alone answering machine, telephone answering system 140 is included in or attached to the receiving telephone. In addition, as used herein, a message stored on an answering system may be any type of message that can be left on the particular answering system. Traditional answering systems record a caller's analog voice and store the caller's vocal message in either a digital or analog form. Some answering systems also receive digital text messages left by a caller using email or a device, such as a touch-tone phone, an alpha-numeric pager, or a personal digital assistant (PDA).

Nowhere in these paragraphs, or elsewhere, does Rodriguez et al. disclose or suggest translating a message from a source format to message text, as recited in claim 1. Instead, Rodriguez et al. discloses storing a caller's vocal message in either digital or analog form (paragraph 0025), which

means storing the message as either a digitized voice message or analog voice message. This does not imply, as the Examiner appears to be alleging, that Rodriguez et al. discloses translating the caller's vocal message to a digital text message. Nowhere does Rodriguez et al. disclose or suggest such a translation.

Also, Rodriguez et al. does not disclose or suggest converting the message text to an audible message when the message should be delivered to the receiving party, as recited in claim 1. The Examiner alleged that Rodriguez et al. discloses converting a digital text message to an audible message when the message should be delivered to the recipient (Office Action, page 3). Applicants disagree.

Rodriguez et al. discloses that the answering system can receive analog voice messages, as well as digital text messages (paragraph 0025). Rodriguez et al. also discloses that a digital text message may be converted to an audible message using speech synthesis software (paragraph 0028). The digital text message described by Rodriguez et al. is not, however, message text that was generated by translating a message from a source format, as recited in claim 1.

Applicants noted these deficiencies in the Examiner's rejection in the Amendment, filed July 11, 2003. The Examiner maintained the rejection, but did not address Applicants' arguments. If the Examiner maintains this rejection yet again, Applicants respectfully request that the Examiner specifically identify where Rodriguez et al. discloses, or even suggests, translating a message from a source format to message text and converting the message text to an audible message, as recited in claim 1. If the Examiner cannot identify where these features are disclosed by Rodriguez et al., the Examiner must withdraw the rejection.

For at least these reasons, Applicants submit that claim 1 is not anticipated by Rodriguez et al. Claims 2-7, 9-11, and 16-18 depend from claim 1 and are, therefore, not anticipated by Rodriguez et al. for reasons similar to those given with regard to claim 1.

Independent claim 20 includes a combination of features of a message delivery system that includes a message receiver and a call processor. The message receiver is configured to obtain a message intended for a receiving party, determine whether the message should be delivered to the receiving party, and convert the message from a source format to a target format when the message should be delivered to the receiving party. The call processor is configured to convert the message from the target format to an audible format, initiate a telephony call to the receiving party, and deliver the message in the audible format to the receiving party during the telephony call.

Rodriguez et al. does not disclose or suggest features recited in claim 20. For example, Rodriguez et al. does not disclose or suggest a message receiver that converts a message from a source format to a target format when the message should be delivered to the receiving party and a call processor that converts the message from the target format to an audible format.

The Examiner alleged that Rodriguez et al. discloses these features (Office Action, pages 6 and 7). In particular, the Examiner alleged that the "caller's vocal message" reads on the claimed source format, "digital form" and "digital text message" read on the claimed target format, and "audible message" reads on the claimed audible format (Office Action, pages 6 and 7). Applicants disagree with the Examiner's reasoning. The Examiner has identified a message in a voice format and a message in a text format as the claimed message in the target format. In particular, the Examiner identified "digital form" from paragraph 0025 and "digital text message"

from paragraph 0028 of Rodriguez et al. as allegedly being equivalent to the claimed target format.

At paragraph 0025, Rodriguez et al. discloses that a caller's vocal message can be stored in either a digital or analog form. In this case, the digital form corresponds to a digitized voice format. Rodriguez et al. does not disclose converting the digitized voice format to an audible format (probably because it is already in an audible format).

At paragraph 0028, Rodriguez et al. discloses that a digital text message can be converted to an audible message. In this case, the digital text message corresponds to a text message received by the answering system. Rodriguez et al. does not disclose that the digital text message was generated by converting a message from a source format.

Because Rodriguez et al. does not disclose converting a message from a source format to a target format and converting the message from the target format to an audible format, Rodriguez et al. does not disclose or suggest features recited in claim 20.

Applicants noted these deficiencies in the Examiner's rejection in the Amendment, filed July 11, 2003. The Examiner maintained the rejection, but did not address Applicants' arguments. If the Examiner maintains this rejection yet again, Applicants respectfully request that the Examiner specifically identify where Rodriguez et al. discloses, or even suggests, a message receiver that converts a message from a source format to a target format when the message should be delivered to the receiving party and a call processor that converts the message from the target format to an audible format, as recited in claim 20. If the Examiner cannot identify where these features are disclosed by Rodriguez et al., the Examiner must withdraw the rejection.

For at least the foregoing reasons, Applicants submit that claim 20 is not anticipated by Rodriguez et al. Claims 21-29 and 34-36 depend from claim 20 and are, therefore, not anticipated by Rodriguez et al. for at least the reasons given with regard to claim 20.

Independent claim 42 recites features similar to features described above with regard to claim 1. Claim 42 is, therefore, not anticipated by Rodriguez et al. for reasons similar to those given with regard to claim 1. Claims 43-47 depend from claim 42 and are, therefore, not anticipated by Rodriguez et al. for at least the reasons given with regard to claim 42.

In paragraph 6 of the Office Action, the Examiner rejected claims 12, 13, 30, and 31 under 35 U.S.C. § 103(a) as allegedly unpatentable over Rodriguez et al. in view of McAllister et al. Applicants traverse the rejection.

The McAllister et al. patent cannot be used as prior art against this application under 35 U.S.C. § 103. Effective November 29, 1999, subject matter that was prior art under 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person (35 U.S.C. § 103(c)). The subject matter of the McAllister et al. patent and the claimed invention of the present application were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely Verizon. Therefore, the McAllister et al. patent cannot be used as prior art against this application under 35 U.S.C. § 103.

Applicants noted this deficiency in the Examiner's rejection in the Amendment, filed July 11, 2003. The Examiner maintained the rejection without addressing Applicants' arguments.

Because the McAllister et al. patent is not prior art against this application, any rejection based on the McAllister et al. patent must be withdrawn.

For at least the foregoing reasons and the reasons given above with regard to claims 1 and 20 (from which claims 12, 13, 30, and 31 depend), Applicants submit that claims 12, 13, 30, and 31 are patentable over Rodriguez et al.

In paragraph 7 of the Office Action, the Examiner rejected claim 19 under 35 U.S.C. § 103(a) as allegedly unpatentable over Rodriguez et al. in view of Schiavone et al. Applicants respectfully traverse the rejection.

Independent claim 19 recites a combination of features of a system for presenting a message to a receiving party. The system includes means for obtaining a user profile corresponding to the receiving party, means for obtaining a message intended for the receiving party, and means for testing the message against the user profile, where the user profile specifies at least one of a date and time of message arrival. The system also includes means for converting the message to an audible message when the message passes the test, means for initiating a telephony call to the receiving party, and means for presenting the audible message to the receiving party during the telephony call.

Neither Rodriguez et al. nor Schiavone et al., whether taken alone or in any reasonable combination, discloses or suggests features recited in claim 19. For example, neither Rodriguez et al. nor Schiavone et al. discloses or suggests means for testing a message against a user profile, where the user profile specifies at least one of a date and time of message arrival.

The Examiner alleged that Rodriguez et al. discloses a user profile that specifies a date and time of message arrival and cited Figure 4 and paragraphs 0034 and 0037-0039 of Rodriguez

et al. for support (Office Action, page 11). The Examiner further alleged that Schiavone et al. discloses checking a message against a recipient profile and cited paragraph 0042 of Schiavone et al. for support (Office Action, page 11). Applicants submit that neither of these references provides support for the Examiner's allegation.

At Figure 4, Rodriguez et al. illustrates a flowchart of a voice mail system forwarding urgent messages to alternative phone numbers (paragraph 0021). Nothing in this figure, or the description thereof, discloses or suggests a user profile that specifies a date and time of message arrival, as alleged by the Examiner.

At paragraph 0034, Rodriguez et al. discloses:

> The header for the first urgent message that was read during input 305 is played for the user informing the user of the date and time that the message was received (output 350). The message is then played for the user (output 355). The user is often given choices on actions to perform to the previously played message. The system receives the user's action (input 360) and responds accordingly. Decision 365 determines whether the user wants to delete the message. If the user requests deletion of the message, "yes" branch 368 is taken whereupon the message is deleted (step 370) from voice mail storage 310. On the other hand, if the previously played message is not to be deleted, "no" branch 372 is taken whereupon the urgent message is moved (step 375) from the urgent message area to the normal message area (or flags corresponding with the message are set accordingly) so that the system does not continue to call the user and play the same urgent messages repeatedly.

This section of Rodriguez et al. discloses that information regarding the date and time that a message was received is played for a user. Nothing in this section, however, discloses or suggests a user profile that specifies a date and time of message arrival, as alleged by the Examiner.

At paragraphs 0037-0039, Rodriguez et al. discloses:

> FIG. 4 is a flowchart of the voice mail system forwarding urgent messages to alternative phone numbers. Processing commences at 400 whereupon urgent message data is read (input 405) from voice mail storage 410. User preferences are read (input 415) from user

> profile 420. The user can specify one or more alternate locations to be contacted in the event of urgent messages. These alternate locations are stored in user profile 420. User profile 420 is a file or database stored on nonvolatile storage accessible to the voice mail system. In a mobile telephone network, user profiles would be stored at the mobile telephone company. In a corporate voicemail setting, the user profiles would be stored in a location accessible to the centralized voicemail system. In a stand alone telephone answering system, such as an answering machine, the alternative locations are stored in a nonvolatile storage area within the answering machine.
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> Decision 425 is made to determine whether the user wants to have urgent messages forwarded to alternate locations. If the user does not wish to forward messages, decision 425 branches to "no" branch 428 whereupon message forwarding processing ends at 430. On the other hand, if the user has requested message forwarding, "yes" branch 432 is taken whereupon the first forwarding address is read (input 435) from user profile 420. If the first Forwarding address is a pager, decision 440 branches to "yes" branch 442.
>
> Pager processing includes dialing the specified pager number (step 445) and sending a digital message (step 450) informing the user of the urgent message. Simple pagers may only accept a limited number of digits as a message in which case the voicemail number or other preset number (i.e. "911-911") is left to inform the user that urgent messages have been received. In more complex alphanumeric pagers, a variety of information can be included such as the date and time of the message, the caller id information corresponding to the caller that left the message, and even the contents of the message using speech recognition software.

Nothing in this section discloses or suggests a user profile that specifies a date and time of message arrival, as alleged by the Examiner. Accordingly, Rodriguez et al. provides no support for the Examiner's allegation. Schiavone et al. also provides no support for the Examiner's allegation.

At paragraph 0042, Schiavone et al. discloses:

> It should also be noted that the present invention can be used for more than just the most common forms of electronic mail messages. For example, the present invention may also advantageously be used for instant messages such as AOL's Instant Messenger messages or ICQ's instant messages. For example, instant messages can be sent as COPPA compliant by specifying a COPPA rule as associated with the instant messages. Any incoming instant messages would then be check against the recipient profile information in accordance with the COPPA rule to determine whether the instant message should be delivered or rejected (for non-compliance of the recipient data with the rule). Additionally, the rule-based processing can be used for outgoing requests or transmissions, event such transmission which are not electronic mail transmissions. For example, a web browser request for data from a particular URL could be processed in

> accordance with a rule and a recipient profile. For example, a child's recipient profile may indicate his young age (under 21) and the parent's recipient profile may indicate his older age (over 21), and a rule may be specified as applicable to all web browser requests. For a web browser request having an associated rule (e.g., a URL pointing to an adult content website may be associated with an "OVER 21 YEARS OF AGE" rule), and the rule will be checked against the outgoing browser request and blocked if the recipient profile data is not in compliance with the rule. In other words, the web browser request is processed as a function of the rule. For example, the parent may be able to obtain access while the child will not.

This section of Schiavone et al. discloses that an incoming instant message is checked against recipient profile information to determine whether the instant message should be delivered or rejected. Schiavone et al. does not disclose or suggest that the profile information specifies at least one of a date and time of message arrival. Because neither Rodriguez et al. nor Schiavone et al. discloses or suggests a user profile that specifies at least one of a date and time of message arrival, as recited in claim 19, Rodriguez et al. and Schiavone et al. do not disclose or suggest features recited in claim 19.

For at least the foregoing reasons, Applicants submit that claim 19 is patentable over Rodriguez et al. and Schiavone et al., whether taken alone or in any reasonable combination.

In paragraph 8 of the Office Action, the Examiner rejected claims 14, 15, 32, 33, 37-41, 48, and 49 as allegedly unpatentable over Rodriguez et al. in view of Tullis et al. Applicants respectfully traverse the rejection.

Claims 14 and 15 depend from claim 1. The disclosure of Tullis et al. does not cure the deficiencies in the disclosure of Rodriguez et al. identified above with regard to claim 1. Therefore, claims 14 and 15 are patentable over Rodriguez et al. and Tullis et al. for at least the reasons given with regard to claim 1. Claims 14 and 15 are also patentable for reasons of their own.

Claims 14 and 15 recite determining whether one or more message attachments are convertible into text, generating a description of the one or more message attachments when the one or more message attachments are not convertible into text (claim 14), and translating the message text and the generated description into an audible message (claim 15). Neither Rodriguez et al. nor Tullis et al. discloses or suggests these features.

The Examiner admitted that Rodriguez et al. does not disclose the first two features, but alleged that Rodriguez et al. discloses the third feature (Office Action, pages 12 and 13). The Examiner further alleged that Tullis et al. discloses the first and second features (Office Action, pages 12 and 13). Applicants submit that the Examiner reasoning is flawed. If Rodriguez et al. does not disclose determining whether one or more message attachments are convertible into text or generating a description of the one or more attachments when the one or more attachments are not convertible into text, then Rodriguez et al. CANNOT disclose or suggest translating the text message and the generated description into an audible message. Therefore, contrary to the Examiner's allegation, neither Rodriguez et al. nor Tullis et al., whether taken alone or in any reasonable combination, discloses or suggests generating a description of one or more message attachments and translating the generated description into an audible message, as recited in claims 14 and 15.

For at least these reasons, Applicants submit that claims 14 and 15 are patentable over Rodriguez et al. and Tullis et al., whether taken alone or in any reasonable combination.

Claims 32 and 33 depend from claim 20. The disclosure of Tullis et al. does not cure the deficiencies in the disclosure of Rodriguez et al. identified above with regard to claim 20. Therefore, claims 32 and 33 are patentable over Rodriguez et al. and Tullis et al. for at least the

reasons given with regard to claim 20. Claims 32 and 33 also recite features similar to features described above with regard to claims 14 and 15. Claims 32 and 33 are, therefore, also patentable over Rodriguez et al. and Tullis et al. for reasons similar to those given with regard to claims 14 and 15.

Independent claim 37 recites features similar to features described above with regard to claims 14 and 15. Claim 37 is, therefore, patentable over Rodriguez et al. and Tullis et al., whether taken alone or in any reasonable combination, for reasons similar to those given with regard to claims 14 and 15. Claims 38-41 depend from claim 37 and are, therefore, patentable over Rodriguez et al. and Tullis et al. for at least the reasons given with regard to claim 37.

Independent claim 48 recites features similar to the features described above with regard to claim 37. Claim 48 is, therefore, patentable over Rodriguez et al. and Tullis et al. for reasons similar to those given with regard to claim 37. Claim 49 depends from claim 48 and is, therefore, patentable over Rodriguez et al. and Tullis et al. for at least the reasons given with regard to claim 48.

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

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